

## § 2.42

## 37 CFR Ch. I (7–1–15 Edition)

be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) *Other evidence.* In appropriate cases, where the applicant claims that a mark has become distinctive of the certified goods or services program, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the authorized users' use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(e) *Certification marks with geographical matter.* Paragraph (d) of this section does not apply to geographical matter in a certification mark certifying regional origin because section 2(e)(2) of the Act does not apply to certification marks that are indications of regional origin.

### § 2.42 Concurrent use.

An application for registration as a lawful concurrent user shall specify and contain all the elements required by the preceding sections. The applicant in addition shall state in the application the area, the goods, and the mode of use for which applicant seeks registration; and also shall state, to the extent of the applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; registrations issued to or applications filed by such others, if any; the areas of such use; the goods on or in connection with which such use is made; the mode of such use; and the periods of such use.

[54 FR 34897, Aug. 22, 1989]

EFFECTIVE DATE NOTE: At 80 FR 33181, June 11, 2015, § 2.42 was revised, effective July 11, 2015. For the convenience of the user, the revised text is set forth as follows:

### § 2.42 Concurrent use.

(a) Prior to seeking concurrent use, an application for registration on the Principal Register under the Act must assert use in commerce and include all the application elements required by the preceding sections, in addition to § 2.44 or § 2.45, if applicable.

(b) The applicant must also include a verified statement that indicates the following, to the extent of the applicant's knowledge:

(1) For a trademark or service mark, the geographic area in which the applicant is using the mark in commerce; for a collective mark or certification mark, the geographic area in which the applicant's members or authorized users are using the mark in commerce;

(2) For a trademark or service mark, the applicant's goods or services; for a collective trademark, collective service mark, or certification mark, the applicant's members' or authorized users' goods or services; for a collective membership mark, the nature of the applicant's collective membership organization;

(3) The mode of use for which the applicant seeks registration;

(4) The concurrent users' names and addresses;

(5) The registrations issued to or applications filed by such concurrent users, if any;

(6) For a trademark or service mark, the geographic areas in which the concurrent user is using the mark in commerce; for a collective mark or certification mark, the geographic areas in which the concurrent user's members or authorized users are using the mark in commerce;

(7) For a trademark or service mark, the concurrent user's goods or services; for a collective trademark, collective service mark, or certification mark, the concurrent user's members' or authorized users' goods or services; for a collective membership mark, the nature of the concurrent user's collective membership organization;

(8) The mode of use by the concurrent users or the concurrent users' members or authorized users; and

(9) The time periods of such use by the concurrent users or the concurrent users' members or authorized users.

(c) For the requirements to amend an application to concurrent use, see § 2.73.

(d) For the requirements of a concurrent use proceeding, see § 2.99.

### § 2.43 Service mark.

In an application to register a service mark, the application shall specify and contain all the elements required by the preceding sections for trademarks, but shall be modified to relate to services instead of to goods wherever necessary.

(Sec. 3, 60 Stat. 429; 15 U.S.C. 1052)

### § 2.44 Collective mark.

(a) In an application to register a collective mark under section 1(a) of the Act, the application shall specify and contain all applicable elements required by the preceding sections for trademarks, but shall, in addition,

specify the class of persons entitled to use the mark, indicating their relationship to the applicant, and the nature of the applicant's control over the use of the mark.

(b) In an application to register a collective mark under section 1(b), section 44 or section 66(a) of the Act, the application shall specify and contain all applicable elements required by the preceding sections for trademarks, but shall also specify the class of persons intended to be entitled to use the mark, indicating what their relationship to the applicant will be, and the nature of the control applicant intends to exercise over the use of the mark.

[54 FR 37590, Sept. 11, 1989, as amended at 73 FR 67769, Nov. 17, 2008]

EFFECTIVE DATE NOTE: At 80 FR 33181, June 11, 2015, § 2.44 was revised, effective July 11, 2015. For the convenience of the user, the revised text is set forth as follows:

**§ 2.44 Requirements for a complete collective mark application.**

(a) A complete application to register a collective trademark, collective service mark, or collective membership mark must include the following:

(1) The requirements specified in § 2.32(a) introductory text through (a)(4), (a)(8) through (10), (c), and (d);

(2)(i) For a collective trademark or collective service mark, a list of the particular goods or services on or in connection with which the applicant's members use or intend to use the mark; or

(ii) For a collective membership mark, a description of the nature of the membership organization such as by type, purpose, or area of activity of the members; and

(iii) In a U.S. application filed under section 44 of the Act, the scope of the goods or services or the nature of the membership organization covered by the section 44 basis may not exceed the scope of the goods or services or nature of the membership organization in the foreign application or registration.

(3)(i) For a collective trademark or collective service mark application, the international class of goods or services, if known. See § 6.1 of this chapter for a list of the international classes of goods and services; or

(ii) For a collective membership mark application filed under sections 1 or 44 of the Act, classification in U.S. Class 200; and for a collective membership mark application filed under section 66(a) of the Act, the international class(es) assigned by the International Bureau in the corresponding international registration.

(4) One or more of the following five filing bases:

(i) *Use in commerce under section 1(a) of the Act.* The requirements for an application under section 1(a) of the Act are:

(A) A statement specifying the nature of the applicant's control over the use of the mark by the members;

(B) For a collective trademark or collective service mark, the date of the applicant's member's first use of the mark anywhere on or in connection with the goods or services and the date of the applicant's member's first use of the mark in commerce; or for a collective membership mark, the date of the applicant's member's first use anywhere to indicate membership in the collective organization and the date of the applicant's member's first use in commerce. If the application specifies more than one item of goods or services in a class, the dates of use are required for only one item of goods or services specified in that class;

(C) One specimen showing how a member uses the mark in commerce; and

(D) A verified statement alleging:

That the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that the applicant is exercising legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons except members have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods, services, or collective membership organization of such other persons to cause confusion or mistake, or to deceive; that the specimen shows the mark as used in commerce by the applicant's members; and that the facts set forth in the application are true.

(ii) *Intent-to-use under section 1(b) of the Act.* The requirement for an application based on section 1(b) of the Act is a verified statement alleging:

That the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons, except members, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods, services, or collective membership organization of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

(iii) *Registration of a mark in a foreign applicant's country of origin under section 44(e) of the Act.* The requirements for an application under section 44(e) of the Act are:

(A) The requirements of § 2.34(a)(3)(ii) and (iii); and

(B) A verified statement in accordance with paragraph (a)(4)(ii) of this section.

(iv) *Claim of priority, based upon an earlier-filed foreign application, under section 44(d) of the Act.* The requirements for an application under section 44(d) of the Act are:

(A) The requirements of § 2.34(a)(4)(i) and (iii); and

(B) A verified statement in accordance with paragraph (a)(4)(ii) of this section.

(v) *Extension of protection of an international registration under section 66(a) of the Act.* The requirement for an application under section 66(a) of the Act is a verified statement alleging that the applicant/holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation; that the signatory is properly authorized to execute the declaration on behalf of the applicant/holder; and that to the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity, except members, has the right to use the mark in commerce that the U.S. Congress can regulate either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods, services, or collective membership organization of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive.

(b) *Verification not filed within reasonable time or omitted.* (1) If the verified statement in paragraph (a)(4)(i)(D), (a)(4)(ii), (a)(4)(iii)(B), or (a)(4)(iv)(B) of this section is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting that, as of the application filing date, the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in commerce; or, as of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce; or

(2) If the verified statement in paragraph (a)(4)(i)(D), (a)(4)(ii), (a)(4)(iii)(B), (a)(4)(iv)(B), or (a)(4)(v) of this section is not filed with the initial application, the verified statement must also allege that, as of the application filing date, the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in commerce; or, as of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce.

(c) *More than one basis.* In an application under section 1 or 44 of the Act, an applicant may claim more than one basis, provided the

applicant satisfies all requirements for the bases claimed. In such case, the applicant must specify each basis, followed by the goods, services, or collective membership organization to which that basis applies. An applicant must specify the goods, services, or collective membership organization covered by more than one basis. Section 1(a) and 1(b) of the Act may not both be claimed for identical goods, or services, or the same collective membership organization in one application. A basis under section 66(a) of the Act may not be combined with another basis.

(d) *In an application for concurrent use under § 2.42,* the verified statement in paragraph (a)(4)(i)(D) of this section must be modified to indicate that no other persons except members and the concurrent users as specified in the application have the right to use the mark in commerce.

(e) *Multiple-class applications.* For the requirements of a multiple-class application, see § 2.86.

#### § 2.45 Certification mark.

(a) In an application to register a certification mark under section 1(a) of the Act, the application shall include all applicable elements required by the preceding sections for trademarks. In addition, the application must: Specify the conditions under which the certification mark is used; allege that the applicant exercises legitimate control over the use of the mark; allege that the applicant is not engaged in the production or marketing of the goods or services to which the mark is applied; and include a copy of the standards that determine whether others may use the certification mark on their goods and/or in connection with their services.

(b) In an application to register a certification mark under section 1(b), section 44 or section 66(a) of the Act, the application shall include all applicable elements required by the preceding sections for trademarks. In addition, the application must: specify the conditions under which the certification mark is intended to be used; allege that the applicant intends to exercise legitimate control over the use of the mark; and allege that the applicant will not engage in the production or marketing of the goods or services to which the mark is applied. When the applicant files an allegation of use under § 2.76 or § 2.88, the applicant must submit a copy of the standards that determine whether others may use the